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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/017,407 | 12/13/2001 | Kevin P. Baker | P2830PIC61 | 8089 |
| 35489 | 7590 | 11/15/2005 | EXAMINER | |
| HELLER EHRLMAN LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506 | | | NICKOL, GARY B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1642 | |

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/017,407 | BAKER ET AL. |
| | Examiner | Art Unit |
| | Gary B. Nickol Ph.D. | 1642 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 August 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 31-35,38-40 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 33,38-40 and 44-47 is/are allowed.
- 6) Claim(s) 31,32,34 and 35 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

Re: Baker *et al.*

Date of priority: 02-18-2000

Response to Amendment

The Amendment filed 08-12-2005 in response to the Office Action of 05-19-2005 is acknowledged and has been entered.

Claims 31-35, 38-40, 44-47 are pending.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Rejection Maintained:

Claims 31-32, and 34-35 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated nucleic acid comprising SEQ ID NO:35, does not reasonably provide enablement for isolated nucleic acids encoding polypeptides of SEQ ID NO:306 for the reasons of record in the Action mailed 05-19-2005.

Initially, applicants argue (Response, pages 8-9) that the instant claims are directed to nucleic acids, not polypeptides. And, given the described use for the claimed nucleic acids, there is no need to discuss uses for the encoded polypeptides. Thus, applicants assert that the discussion of protein expression levels is irrelevant. Applicants further assert that the instant

specification provides ample guidance to allow one of ordinary skill in the art to identify, make and use those variants covered by the claims. Applicants note that Example 143 of the present application provides step-by-step guidelines and protocols for the gene amplification assay and that by following the disclosure in the specification, one skilled in the art can easily test whether a gene encoding a variant PR01558 protein is amplified in lung or colon tumors. Applicants further argue that the specification describes methods for the determination of percent identity between two amino acid sequences. (See page 302, line 4, to page 305, line 4). Further, applicants argue that the specification teaches specific parameters to be associated with the term "percent identity" as applied to the present invention. Accordingly, one of skill in the art could identify whether the variant PR01558 sequence falls within the parameters of the claimed invention. Once such an amino acid sequence is identified, the specification sets forth methods for making the amino acid sequences (see page 354, line 30 to page 358, line 34) and methods of preparing the PRO polypeptides (see page 358, line 35 and onward).

These arguments have been carefully considered but are not found persuasive. The specification only describes and enables one species of DNA that is amplified in lung or colon tumors~ not a genus of variant DNA molecules. There is no evidence that other variant encoding DNA molecules would predictably be amplified in lung or colon tumors. Further, as set forth previously, degenerate or variant polynucleotides do not necessarily predict protein expression. Therefore, the discussion of protein levels is relevant because applicants have not demonstrated that any of the DNA molecules encode functionally relevant PRO1558 proteins. Thus, the ordinary skilled artisan would have to *assume* that all of the encompassed variant nucleic acids encode functionally relevant products because the disclosure does not demonstrate evidence that

the encoded product in translated in lung or colon tumors. Thus, applicant's arguments have not been found persuasive, and the rejection is maintained.

All other rejections and or objections are withdrawn in view of applicant's amendments and arguments there to.

Claims 33, 38-40, 44-47 appear allowable.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary B. Nickol Ph.D. whose telephone number is 571-272-0835. The examiner can normally be reached on M-Th, 8:30-5:30; alternate Fri., 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary B. Nickol Ph.D.
Primary Examiner
Art Unit 1642

GBN



**GARY B. NICKOL, PH.D.
PRIMARY EXAMINER**